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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/117,214	07/24/1998	ALASTAIR HUGH SERVANTE	292/30.35.37	3424

7590 07/01/2003

WENDEROTH LIND & PONACK
2033 K STREET NW
SUITE 800
WASHINGTON, DC 20006

EXAMINER

PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/01/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

Mail

Office Action Summary

Applicati n N .

09/117,214

Applicant(s)

SERVANTE ET AL.

Examiner

Christopher C Pratt

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the c rresp ndence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 5/15/03 have been entered and carefully considered. Applicant's amendment is found to overcome the 112 rejections previously set forth because the amendment canceled the rejected claims. Despite this advance, the amendments are not found to patently distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 33-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not describe how the water-dispersible polymer and the ethylenically unsaturated compound of claim 33 would not react with each other when "irradiated with UV radiation." These polymers should inherently react when irradiated. This is evidenced in Mehta (5219641). Mehta uses the same polymer combination, as set forth in previous actions, and irradiates the mixture to induce cross-

linking, i.e. the mixture reacts with each other. Applicant's specification does not describe how to keep this mixture from reacting when irradiated.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 34-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is indefinite because it requires the water-dispersible polymer to form a matrix in which the second component is dispersed. However, claim 34 depends from claim 33, which allows for only 10% of the polymer and 90% of the second component. These ratios would not allow the polymer to form a matrix in which the second component could be dispersed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 33 and 35-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehta et al (5219641), as set forth in the previous action.

Applicant argues that Mehta's water dispersible polymer is different from the polymer of the instant invention because it does not provide a "smooth" film surface.

This is not persuasive because Mehta specifically teaches that a smooth surface is created (col. 2, lines 31-33).

Applicant argues that the polymer combination used by Mehta is different from the instant combination because Mehta's polymers are cross-linked by UV radiation and no unreacted groups remain. This argument is not commensurate in scope with the instant claims. Applicant's claims do not specify that the polymer combination is not cross-linked such that unreacted groups remain to interface with inks. Moreover, applicant's specification teaches that the instant invention can be cross-linked (p. 4, lines 22-23 and p. 5, lines 8-10). This cross-linking process would react the previously unreacted groups.

Applicant argues that col. 2, lines 28-31 of Mehta teach pre-printing. Applicant argues that this teaches away from the instant invention because it adds additional layers. This argument is not persuasive because Mehta clearly teaches this option as an alternative embodiment. Earlier in the same paragraph, Mehta states that the coating can be applied to coated or uncoated substrates (col. 2, lines 16-19). Moreover, this argument is not commensurate in scope with the claims. Applicant uses the open transitional language "comprising," which allows for the incorporation of other materials and layers.

Applicant argues that in the instant invention the ethylenically unsaturated compound acts as a plasticizer and plasticizes the polymer. It is the examiner's position that the ethylenically unsaturated compound of Mehta would inherently act as a

plasticizer. The examiner notes that Mehta uses the same polymer combination taught by applicant.

Applicant argues that the instant invention is different from Mehta because Mehta uses an oligomer. Applicant's claims require a polymer and an oligomer is a polymer.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 34 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mehta (5219641), as set forth in the last action.

Applicant argues that the instant invention is able to form a matrix because it utilizes a polymer instead of the oligomer used by Mehta. This argument is not persuasive because an oligomer is simply a type of polymer. There is no evidence that an oligomer would not act like other polymers to form a matrix.

Applicant argues that Mehta's combination does not form a matrix. However, applicant argues that the polymer used in the instant invention inherently forms a matrix even when as little as 10% is used. Therefore, it is the examiner's position that the combination of Mehta would also inherently form a matrix because Mehta uses the same water-dispersible polymer.

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10. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al (5219641) in view of Kuburaki et al (5047286), as set forth in the last action.

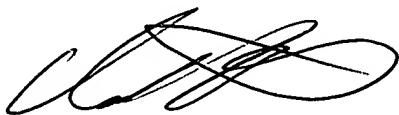
Applicant argues that Mehta and Kuburaki are not combinable because they deal with different methods of printing. This argument is not persuasive because both references are drawn to printing.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Christopher C. Pratt
June 27, 2003



CHERYL A. JUSKA
PRIMARY EXAMINER